

REMARKS/ARGUMENTS

Prior to the entry of this Amendment, claims 38 and 39 were pending in this application. Claim 38 has been amended and new claims 40 and 41 have been added herein. No claims have been cancelled herein. Therefore, claims 38-41 are now pending in this application. Applicants respectfully request reconsideration of these claims for at least the reasons presented below.

35 U.S.C. § 103 Rejection, McLeod in view of Kung

The Final Office Action rejected claim 38 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,222,120 of McLeod et al. (hereinafter McLeod) in view of U.S. Patent No. 6,373,817 of Kung et al. (hereinafter Kung). The Applicant respectfully submits that the Office Action does not establish a *prima facie* case of obviousness in rejecting these claims, as amended. Therefore, the Applicant requests reconsideration and withdrawal of the rejection.

In order to establish a *prima facie* case of obviousness, the Office Action must establish: 1) some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or combine their teachings; 2) a reasonable expectation of success of such a modification or combination; and 3) a teaching or suggestion in the cited prior art of each claimed limitation. See MPEP §706.02(j). As will be discussed below, the references cited do not teach or suggest each claimed limitation.

McLeod discloses a long distance switching system that is adapted to provide enhanced subscriber services, including audio news and information service. (Abstract) To access these services, a subscriber initiates a long distance telephone call (Col. 4, lines 25-29). To the extent McLeod discloses the delivery of information services, it does so only upon the

entry of a command by the subscriber and then only in the form of an audible menu from which the subscriber chooses the information to receive (Col. 24, lines 29-57).

Kung discloses a "chase me" system for routing messages to subscribers (Abstract). In one aspect, Kung discloses that an announcement server may detect when a device has been taken off-hook and play random advertisements or other announcements to the user (Col. 10, lines 13-15).

However, McLeod and Kung, either alone or in combination, fail to teach or suggest each claimed limitation. For example, neither McLeod nor Kung teaches or suggests determining services to provide to a subscriber based on a frequency with which the subscriber selects to receive a selection of information services, where the frequency is indicated by a number of calls selected by the subscriber as recited in claim 38. For at least these reasons, claim 38 should be allowed.

Furthermore, the combination of McLeod and Kung fails to teach or suggest each claimed limitation of new claims 40 and 41. For example, neither McLeod nor Kung teaches or suggests detecting at the network component of the communications network a signal from the subscriber; ending the information services to the subscriber; and providing the dial tone to the subscriber via the communications network in place of the information services, i.e., allowing the subscriber to switch back to a dial tone from the information services, as recited in claims 40 and 41. Nor does the combination teach or suggest determining services to provide to a subscriber based on a frequency with which the subscriber selects to receive a selection of information services, where the frequency is indicated by a number of calls selected by the subscriber as recited in claim 41. For at least these reasons, claims 40 and 41 should be allowed.

35 U.S.C. §103 Rejection, McLeod in view of Kung and Valliani

The Final Office Action rejected claim 39 under 35 U.S.C. §103(a) as being unpatentable over McLeod in view of Kung and further in view of U.S. Patent No. 6,311,063 of Valliani et al. (hereinafter Valliani). The Applicant respectfully submits that the Office Action does not establish a *prima facie* case of obviousness in rejecting these claims. Therefore, the Applicant requests reconsideration and withdrawal of the rejection.

Valliani is directed to "a method and a system of allowing a single mobile phone to emulate the subscriber profile--set of features ('SOF'), such as call waiting, call forwarding, three-way calling, conference calling, voice mail service, etc.--of multiple mobile phone users." (Col. 1, lines 38-42). As with McLeod and Kung, Valliani fails to teach or suggest, alone or in combination with McLeod and Kung, determining services to provide to a subscriber based on a frequency with which the subscriber selects to receive a selection of information services, where the frequency is indicated by a number of calls selected by the subscriber as recited in claim 38, upon which claim 39 depends. For at least these reasons, claim 39 should be allowed.

Furthermore, the combination of McLeod, Kung, and Valliani fails to teach or suggest each claimed limitation of new claims 40 and 41. For example, none of the references teach or suggest detecting at the network component of the communications network a signal from the subscriber; ending the information services to the subscriber; and providing the dial tone to the subscriber via the communications network in place of the information services, i.e., allowing the subscriber to switch back to a dial tone from the information services, as recited in claims 40 and 41. Nor does the combination teach or suggest determining services to provide to a subscriber based on a frequency with which the subscriber selects to receive a selection of information services, where the frequency is indicated by a number of calls selected by the subscriber as recited in claim 41. For at least these reasons, claims 40 and 41 should be allowed.

Appl. No. 09/785,863

PATENT

Amdt. dated: February 3, 2006

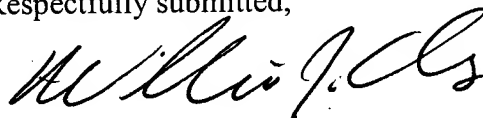
Amendment under 37 CFR 1.114 Request for Continued
Examination

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this
Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of
this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



William J. Daley
Reg. No. 52,471

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, Eighth Floor
San Francisco, California 94111-3834
Tel: 303-571-4000
Fax: 303-571-4321

WJD:sbm

60684858 v1